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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,071	12/04/2003	Michael A. Hodge	038675/258205	7642

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EXAMINER

EDWARDS, NEWTON O

ART UNIT PAPER NUMBER

1774

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/728,071

Applicant(s)

HODGE ET AL.

Examiner

N Edwards

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 23-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/04
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-22, drawn to multi-component fiber, classified in class 428, subclass 370.
- II. Claim 23, drawn to a drawn sheath core fiber, classified in class 428, subclass 373.

If Group I is elected, Applicant is required to an election of species requirement under 35 USC 121 claims 5, 6 and 7.

- III. Claims 24 and 25, drawn to an article (bay filter), classified in class 442 or 55, subclass various.
- IV. Claim 26, drawn to a process of making multi-component fiber, classified in class 264, subclass 172.1.

The inventions are distinct, each from the other because:

Inventions Group I and Group II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as the product as claimed can be made by a materially different process such as spinning, co-extruding, drawing and winding, and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be

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obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Christopher Humphrey on August 16, 2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-22. Affirmation of this election must be made by applicant in replying to this Office action. Claims 23-26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

In accordance with the election of species requirement of August 16, 2004, Applicant elected aromatic polyester for claim 5, polyalkylene terephthates for claim 6, PET for claim 7, and polyester for claim 1.

Claims 9-11 are withdrawn from consideration as being directed to a non-elected invention 37 CFR 1.142 b.

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Applicant is required to submit a translation of JP 6123013, with a response to this office action; failure to comply will result in a non-responsive action.

Claims 20-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20, line 1 "fiber forming component" lack proper antecedent basis rendering the claim indefinite and vague (see claims 21 and 22 for the same problem.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 8, 12, 13, 14, 15-19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 6,123,013.

For the record, the term isotropic semi-crystalline polyester means the same thing as anisotropic polyester.

JP 6,123,013 teaches a multi-component sheath core fiber (include staple and continuous) comprising an anisotropic aromatic polyester (includes PET) core and polyarylene sulfide sheath. JP 6,123,013 drawing shows a core sheath, island in the sea, circular fiber, and multi-global fiber, and concentric sheath core fiber in drawings.

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Regarding the issue of melt blown, melt blow defines the process in which the fiber is made. Therefore, claim 19 is product by process claim in which the invention defines by said claim is a product (fiber of claim 1) and NOT a process. In re Bridgeford, 357 F. 2d 679. Therefore, it is the patentability of the product claimed and NOT of the recited process step(s) which must be established, In re Brown, 459, F.2d 531.

Any inquiry concerning this communication should be directed to Primary Examiner Edwards at telephone number (571) 272-1521.

Edwards/dh
October 15, 2004

A handwritten signature in black ink, appearing to read 'N. Edwards', is positioned above the printed name and title.

N. EDWARDS
PRIMARY EXAMINER